

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. CLARKE STEVENS and CAROL L. STIMMEL

Appeal 2007-2933
Application 09/396,612
Technology Center 3600

Decided: November 6, 2007

Before HUBERT C. LORIN, LINDA E. HORNER, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

MICHAEL W. O'NEILL, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

J. Clarke Stevens et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-8 and 10. We have jurisdiction under 35 U.S.C. § 6(b) (2002). This appeal includes a record that is not ripe for review and pursuant to 37 C.F.R. § 41.50(a)(1) (2007), we remand this application to the Examiner to take appropriate action consistent with our comments below. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2007). The record is not ripe for review for two reasons.

First, the Examiner must provide an explanation of the 35 U.S.C. § 102 rejections. 37 C.F.R. § 1.104(c) provides:

(c) *Rejection of claims.*

.... (2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. *When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.*

37 C.F.R. § 1.104(c) (2007) (emphasis added).

The Examiner's final rejections are quoted below in their entirety:

Claims 1-8 and 10, as best understood in light of any rejections under 35 U.S.C. [§] 112, [second paragraph] hereinabove, are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Green et al.

Claims 1-8 and 10, as best understood in light of any rejections under 35 U.S.C. [§] 112, [second paragraph] hereinabove, are rejected under 35 U.S.C. [§] 102(e) as being clearly anticipated by each of Kenney and Petrovich et al.

(Final Office Action 4, mailed December 9, 2002.) In the Answer, the Examiner does not expound on these rejections, but rather merely reiterates the claim language verbatim and provides no citations to the particular parts of each cited reference relied upon as the basis for each rejection (Answer 4-7).

The references, Green et al., Kenney, and Petrovich et al., are complex in nature and show inventions other than that claimed by the Appellants. Upon remand, if the Examiner maintains these rejections, he

must provide an explanation of each rejection that specifically points the Appellants and the Board to the particular part of each reference relied on as the basis for the rejection of each claim, and he must discuss the pertinence of each reference.

Second, on remand, the Examiner should consider whether the claims recite patentable subject matter under 35 U.S.C. § 101 in light of the recent decision of *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007).

In *Comiskey*, the court provided guidance on the determination of patentable subject matter under 35 U.S.C. § 101. The court explained that “[t]he prohibition against patenting of abstract ideas has two distinct (though related) aspects.” *Id.* at 1376. The court stated that, “[f]irst, when an abstract concept has no claimed practical application, it is not patentable. ... Second, the abstract concept may have a practical application.” *Id.* In the latter case where the abstract concept has a claimed practical application, the court noted “[i]n that context [of process claims directed to industrial processes], the Supreme Court has held that a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e. a machine, manufacture, or composition of matter. 35 U.S.C. § 101.” *Id.*

In view of *Comiskey*, the Examiner should consider whether the subject matter of the claimed process is an abstract idea that, though directed to an industrial application, is not embodied in, and does not operate on, transform, or otherwise involve another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter.

The Specification does not appear to define any terms in the claimed steps in a manner inconsistent with the plain usage of that term in the art. As plainly understood in the art, the claimed steps do not appear to be embodied in and do not appear to operate on, transform, or otherwise involve a machine, manufacture or composition of matter. For example, to one of ordinary skill in the art, the term “shopping lists” broadly covers any means that provides a list of items for which one would shop. That would include a list formed in the mind, i.e., a mental step. The same conclusion may be reached for the terms “trend,” “predictive,” “receiving,” and “recommending.” “Following the lead of the Supreme Court, this court and our predecessor court have refused to find processes patentable when they merely claimed a mental process standing alone and untied to another category of statutory subject matter even when a practical application was claimed.” *Id.* at 1378. Therefore, given the broadest reasonable construction of the claim in light of the specification as it would be interpreted by one of ordinary skill in the art, it would appear that each step of the claimed process covers subject matter which is not “embodied in, operates on, transforms or otherwise involves another class of statutory subject matter.”

The same may be said for the preamble. Though the preamble calls for “using a programmed device accepting input data and executing instructions for automating inventory management,” which arguably requires “a programmed device” (i.e., a machine) to practice the process steps which follow in the body of the claim and thus “embody” the process

claimed,¹ “the mere use of [a] machine to collect data necessary for application of the mental process may not make the claim patentable subject matter,” *Id.* at 1380 (citing *In re Grams*, 888 F.2d 835, 839-840 (Fed. Cir. 1989)). Upon remand, the Examiner should carefully read the claim in light of the Specification and ascertain whether the device set forth in the preamble to claim 1 gives life and meaning to the claimed process such that the steps claimed would be understood by one of ordinary skill in the art as describing the operation of “a preprogrammed device” or whether the preamble’s recitation of “a preprogrammed device” adds little or nothing to the subject matter of the claim beyond reciting the mere routine use of a device as part of process that is wholly a combination of mental processes. If the Examiner determines the former, the claim as a whole may be directed to patentable subject matter. However, if the Examiner determines the latter, the Examiner would need to consider whether the claim as a whole would be a mental process having a practical application that is not embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter and thus would *not* comply with 35 U.S.C. § 101 because “mental processes – or processes of human thinking – standing alone are not patentable even if they have a practical application.” *Id.* at 1377.

¹ “When an unpatentable mental process is combined with a machine, the combination may produce patentable subject matter, as the Supreme Court’s decision in *Diehr* and our own decisions in *State Street Bank* and *AT&T* have confirmed.” *Id.* at 1379.

ORDER

Accordingly, it is ORDERED that the application is remanded to the Examiner:

- 1) to identify by column and line and, if necessary, by figure and element number, the particular parts relied upon within each reference for each claim rejection, if maintained. Further, the Examiner is required to clearly explain the pertinence of each part relied upon because it is not readily apparent how the claims lacks novelty in view of these references;
- 2) to consider the question of patentability of the claims under 35 U.S.C. § 101 in light of *In re Comiskey*; and
- 3) for such further action as may be appropriate.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the board.

REMANDED

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BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD MI 48075